

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant : William L. Thomas
Application No. : 09/809,922 Confirmation No.: 7120
Filed : March 16, 2001
For : SYSTEMS AND METHODS FOR PRESENTING A
LOTTERY INTERFACE IN AN INTERACTIVE
WAGERING APPLICATION
Art Unit : 3714
Examiner : Alex P. Rada

New York, New York 10036
October 9, 2007

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REPLY BRIEF

Sir:

In response to the August 6, 2007 Examiner's Answer and the September, 13, 2007 supplemental Examiner's Answer, appellant is submitting this Reply Brief pursuant to 37 C.F.R. § 41.41(a).

Appellant maintains all of the positions previously set forth and discussed in appellant's Amended Appeal Brief filed on April 19, 2007 ("Appeal Brief"). In addition, appellant herein addresses the Examiner's

statements in the "Response to Argument" section of the Examiner's Answer.

A. The Examiner has failed to point to a reason for modifying Schneier with Archer.

In rejecting claims 1 and 11, the Examiner attempts to combine Schneier et al. U.S. Patent No. 6,402,614 (hereinafter "Schneier") with Archer U.S. Patent No. 6,277,026 (hereinafter "Archer").

To reject an application based on a combination of references, the Examiner should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," and should make the analysis explicit. KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 at 1741 (2007). With respect to independent claims 1 and 11, the Examiner contends that "the motivation to combine can be found within the teaching of Archer" (Examiner's Answer, p. 13, lines 20-21). The Examiner then states:

It is inherently known in lottery [sic] that users may purchase lottery [sic] for different lottery drawings that may take place at a later time. . . . By issuing lottery tickets for lottery drawings for a later time, one of ordinary skill in the art provide [sic] a system that facilitates the sale of lottery tickets without disturbing [sic] bearer-type tickets and the like. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was [sic] modify Schneier to include the purchasing of an electronic ticket for at least one lotteries [sic], wherein the

drawing for the at least one lotteries [sic] will take place at a later time as taught by Archer to provide known methods to yield to [sic] predictable results that allows [sic] a user to retrieve there [sic] results of a lottery ticket either online or an [sic] authorized payment center

(Id. at p. 14, line 13 to p. 15, line 2).

The Examiner is, apparently, arguing that it would have been obvious to modify Schneier in view of Archer to achieve appellant's invention because doing so would allow a user to retrieve lottery results either online or at an authorized payment center. This argument, however, is wholly insufficient and fails to address any of the arguments put forth in appellant's Appeal Brief.

For example, the Examiner fails to indicate why one skilled in the art would modify Schneier from providing instant lotteries to providing lotteries whose associated drawings take place at a later time. The only lotteries that Schneier mentions are instant-type lotteries having predetermined results and Schneier's entire disclosed system is contingent on the fact that the lotteries are instant with predetermined results. In fact, Schneier explicitly states that the advantage of its system is that it permits a user to play without being "physically or electronically connected to a lottery system network." Simply stating, as the Examiner does, that a lottery that

takes place at a later time is inherent, whether true or not, is not a sufficient reason to modify Schneier's system to include lotteries for which drawings take place at a later time (i.e., requiring a connection to a lottery system network (see, e.g., Archer, FIG. 1)).

- B. The Examiner has failed to point to a reason for modifying Dickinson with Rittmaster and Archer.

In rejecting claims 1 and 11, the Examiner attempts to combine Dickinson et al. G.B. Patent No. 2,147,773 (hereinafter "Dickinson") with Rittmaster U.S. Patent Publication No. 2002/0023010 (hereinafter "Rittmaster") and with Archer.

To reject an application based on a combination of references, the Examiner should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," and should make the analysis explicit. KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 at 1741 (2007). With respect to independent claims 1 and 11, the Examiner contends that "the motivation to combine can be found within Rittmaster and Archer" (Examiner's Answer, p. 15, lines 8-9). The Examiner then states:

By modifying Dickinson's gaming terminals to include other various lottery games over the Internet and limiting lottery or game services available over the Internet based on geographic information determined from players would helps

[sic] to ensure lottery legality in certain jurisdictions (paragraph [0006]). Therefore, it would have been obvious to one of ordinary skill in the art to modify lottery terminal [sic] of Dickinson to include determining the particular location of the user and providing a listing of lotteries in which the user can participate on a visual display based on the particular location of the user as taught by Rittmaster to provide a player to participate [sic] in different lotteries that are available based on geographic information determined from the player to ensure lottery legality in certain jurisdictions.

(Id. at p. 15, line 19 to p. 16, line 5).

The Examiner is, apparently, arguing that it would have been obvious to modify Dickinson in view of Rittmaster to achieve appellant's claimed feature of determining the particular location of the user because doing so would "ensure lottery legality in certain jurisdictions." This argument, however, is wholly insufficient and fails to address any of the arguments put forth in appellant's Appeal Brief.

For example, the Examiner fails to indicate why one skilled in the art would modify Dickinson from providing a stationary, stand-alone lottery machine that is preprogrammed to provide certain games to a machine that determines the user's location. Such a modification is inconsistent with Dickinson's disclosure because the machine is always in the same location and is preprogrammed for particular games appropriate for that location.

Determining the user's location is unnecessary and would result in an inefficient use of resources.

C. The Examiner has used improper hindsight in rejecting appellant's claims

In response to the arguments put forth in appellant's Appeal Brief that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, the Examiner quotes In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971):

[I]t must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

(Id. at p. 13, lines 10 to 14).

In rejecting appellant's claims, the Examiner is using improper hindsight reasoning. In particular, the Examiner merely listed the features of appellant's claims and then identified disclosures from various prior art references that cumulatively show these feature. The Examiner failed to indicate how or why one of ordinary skill at the time the claimed invention was made would have combined these various prior art references to arrive at appellant's claimed invention. In fact, the Examiner failed to point to any evidence for combining these

references other than the knowledge gleaned only from appellant's disclosure. This hindsight reasoning is therefore improper.

D. Conclusion

For the reasons set forth above, appellant submits that claims 1-32 are in condition for allowance. The Examiner's rejections of these claims should be reversed.

Respectfully submitted,

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